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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/386,850	08/31/1999	ISABELLE ROSINSKI-CHUPIN	004900-169	1870
21839	7590	03/02/2004	EXAMINER	
BURNS DOANE SWECKER & MATHIS L L P			CANELLA, KAREN A	
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ALEXANDRIA, VA 22313-1404			PAPER NUMBER	

1642

DATE MAILED: 03/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/386,850

Applicant(s)

ROSINSKI-CHUPIN ET AL.

Examiner

Karen A Canella

Art Unit

1642

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 15 and 16 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) 15 and 16 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 March 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☐ Certified copies of the priority documents have been received.
 - 2) ☒ Certified copies of the priority documents have been received in Application No. 07/499,276.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date: ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date: ____ | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

1. Claims 15 and 16 have been amended and are under consideration
2. The text of sections of Title 35, US Code not found in this action can be found in a prior action.
3. The objection to the specification for not complying to the Sequence Rules is maintained. A separate sequence identifier is required for each structure, II-VII, on page 2.
4. The amendment filed December 17, 2003 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: "application Serial No. 07/499,276, filed on October 11, 1989". It is clear from the '276 specification, that the filing date was July 19, 1990, and not the filing date of PCT/FR8800523 which was October 11, 1989. Further, as stated in the previous Office action, the instant SEQ ID NO:7 was present only in the '276 application and not in PCT/FR8800523 because there is a difference of four base pairs between the sequence of the instant and the '276 application versus the sequence of PCT/FR8800523, wherein the differences are at nucleotides 534, 558, 568 and 608. Thus, it is concluded that applicant was not in possession of the instant SEQ ID NO:7 as of the filing date of PCT/FR8800523.
Applicant is required to cancel the new matter in the reply to this Office Action.
5. Claim 15 is objected to because of the following informalities: claim 15 recites "65%" rather than "65 degrees". Appropriate correction is required.
6. The rejection of claims 15 and 16 under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 15 and 16 have been amended to qualify the hybridization by the adjective "stringent".. It is noted that the specification describes one hybridization condition on page 8, lines 6-32. The term stringent hybridization can encompass low, medium or high stringency conditions, dependent on salt concentration and temperatures, and therefore amendment of the claims to stringent hybridization incorporates a wider ranger of hybridization conditions than contemplated by the specification as originally filed. One of skill in the art would conclude that applicant was not in possession of the claimed invention at the time of filing.

Claim 15 has been amended to recite conditions for the exposure of the SEQ ID NO:7 to a DNA or RNA molecule, however, the conditions recited do not specify the conditions for washing which are recognized in the art to determine the actual stringency of the hybridization. The specification teaches on page 8, lines 28-32, specific washing conditions. However, these washing conditions cannot be construed as claim limitations.

7. The rejection of claim 15 and 16 under 35 U.S.C. 102(b) as being anticipated by Rosinski-Chupin et al (PNAS 1988 November, Vol. 85, pp. 8553-8557) is maintained for reasons of record.

Applicant has attempted to overcome this rejection by mistakenly stating that application 07/499,276 was filed on October 11, 1989. The essential disagreement appears to be that the instant SEQ ID NO:7 is not present in PCT/FR89/00523 as evidenced by the attachment provided in the prior Office action which indicates that the instant SEQ ID NO:7 differs from the sequence of the PCT/FR89/00523 application by four nucleotides. Accordingly, for the instant claims which depend on the identity of SEQ ID NO:7, priority is recognized only to U.S. application 07/499,276, filed July 17, 1990. Applicant submits that the copy of the certified FR 8813353 is present in the 07/499,276 application, however a translated copy has not be made of record in the instant application.

8. All other rejections and objections as set forth in the previous Office action are withdrawn.

Art Unit: 1642

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karen A Canella whose telephone number is (571)272-0828. The examiner can normally be reached on 10 a.m. to 9 p.m. M-F.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler can be reached on (571)272-0871. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Karen A. Canella, Ph.D.

Patent Examiner, Group 1642

02/27/04


KAREN A. CANELLA PH.D
PRIMARY EXAMINER